

PATENT

DOCKET NO. 10013.0005US

REMARKS

Applicants are in receipt of the Office Action mailed May 3, 2007, and have the following remarks.

Restriction Requirement

Applicants acknowledge the Restriction Requirement accompanying the Office Action of May 3, 2007, and hereby elect the invention of Group I (claims 1-22) of the present application. Applicants also reserve the right of request rejoinder of the claims of Group II and/or Group III upon an indication that the claims of Group I are allowable.

Objections to the Specification

The Examiner has objected to the specification at paragraphs [0050] and [0076]. Applicants have amended the specification at paragraph [0050] to replace the word "portitioning" with the word "partitioning", and to correct the phrase at line 5 to read "cell motility in blood capillaries". Applicants have also amended paragraph [0076] to provide a period at the end of the sentence at line 19. Applicants appreciate the Examiner bringing these informalities to their attention.

No new matter was added as a result of these corrections. In light of the amendments to paragraphs [0050] and [0076], Applicants submit that this objection has now been overcome.

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Objections to the Claims

Claims 16-22 were objected to as being in improper multiple dependent claims format. Claim 16 has been amended to depend solely from Claim 1; therefore Applicants respectfully submit that this objection is now moot.

Rejection of Claims 1-9 and 14-22 over 35 USC §102(b)

Claims 1-9 and 14-22 were rejected as allegedly lacking novelty over U.S. Patent No. 5,942,443, to Parce et al. Applicants note that the Examiner has not rejected claims 10-13 under 345 USC § 102, and indeed on pages 1-14 has indicated that Parce lacks features contained in these claims.

Accordingly, the features of original claims 10 and 11 have been included into amended claim 1 and claims 10 and 11 have been cancelled. Also because of the incorporation of the elements of claims 10 and 11 into claim 1, claims 5, 6, and 7 have also been cancelled.

Since novelty of claims 10 and 11 was acknowledged in the Office Action, it follows that by way of this amendment, the rejection of the presently amended claims under 35 USC § 102 (b), all of which claims depend directly or indirectly from amended claim 1, has been made moot. For this reason, Applicants respectfully request the Examiner to withdraw this ground of rejection.

Rejection of Claims 10-13 pursuant to 35 USC §102(b)

Claims 10-13 were rejected as allegedly obvious over U.S. Patent No. 5,942,443, to Parce et al., in view of U.S. Patent No. 5,837,115 to Austin et al. Applicants respectfully traverse this rejection for the following reasons.

Claim 11 has been cancelled, and its limitations incorporated into claim 1. To the extent this rejection is considered to be applied against presently amended claim 1, application point out that

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claim 1 of the present application now requires that the widths of the passages increases along the length of the partitioning wall in the claimed device.

Obviousness is determined using the analytical framework set forth by the United States supreme Court in *Graham v. John Deere Co.*, 381 U.S. 1(1966)(hereinafter "*Graham*"). Under this analytical framework, an invention cannot be considered obvious (and thus in violation of 35 U.S.C. §103(a)) unless the difference between the teachings of the prior art and of the claimed invention when taken as a whole are such that a person of ordinary skill in the art would find the claimed invention obvious in light of the prior art.

The United States Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, __ U.S.P.Q.2d ___ (2007) affirms in every regard the standards set forth in *Graham*. Moreover, the *KSR* court indicated that in a proper rejection on obviousness grounds the Examiner must articulate reasoning with some rational underpinning to support the legal conclusion of obviousness, *id.*, slip op. at 14, such as "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [known] elements in the way the claimed new invention does." *Id.*, slip op. at 15.

The presently claimed invention is drawn to devices for studying cell motility, migration, and deformation. The devices are made so that cells may be introduced in a test sample into a fluid medium into a channel of the device containing at least two channels connected by at least one through passage, and studying the migration and deformation of the cells through the through passage.

U.S. Patent No. 5,942,443, to Parce et al. is drawn to a device and method for performing high throughput screening assays of drugs. The devices and method concern continuous flow assays wherein test compounds are injected into a channel, are mixed with bioactive reagents in a fluid stream, and a biological response is automatically detected at a location in a channel downstream from the mixing point.

U.S. Patent No. 5,837,115 to Austin et al., concerns electrophoresis methods capable of being configured to fractionate or separate various substances, including DNA, proteins, polymers, and cells. Importantly, the devices described in Austin will vary according to the material being separated, but,

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once such a material is chosen the "object of the [Austin] invention is to provide a lattice structure in which the distribution, size and shape of the pore[s] therein are substantially uniform." Austin col. 4, line 49-52. While Austin describes various shapes of barriers within channeled devices, and explains that obstacles can have a staggered pattern, or "any predetermined and reproducible pattern", wherein each of the obstacles is separated from an adjacent obstacle by a predetermined separation distance (Sr) to form passages, Austin nowhere describes or suggests a single device in which "the widths of the passages increases along the length of the partitioning wall", as is now claimed in every pending claim in the present application and illustrated in Fig. 9 of the present specification.

Neither does Parce describe such a feature. In addition, the Examiner has not provided any evidence showing why a person of ordinary skill in the art, in possession of both Parce and Austin, would be led to make the present device with a reasonable expectation of success.

Thus, without admitting such, Applicants submit that even if there were as motivation to combine electrophoretic devices (Austin) with high throughput assay devices (Parce) this combination would not result in the device as recited in claim 1 et seq. since Austin, as explained above, does neither disclose nor suggest to have the widths of the through passages increasing along the length of the portioning wall.

For these reasons, Applicants submit that claim 1 and all the pending claims are patentable and respectfully request that the rejection under 35 USC § 103 be withdrawn.

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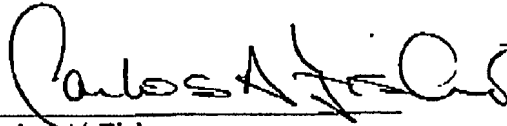
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CONCLUSION

For the reasons stated above, the claims are now believed to be in condition for allowance, and Applicants respectfully request a Notice to that effect.

Since November 3rd, 2007 fell on a Saturday, please use Deposit Account 50-4004 for the payment of a three-month extension of the time to reply. If any other fee is now due, please use this deposit Account for the payment of such deficiency, or to credit any overpayment.

Respectfully submitted,



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